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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,797	10/23/2001	Erik M. Erbe	OVIT-0190	3864

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EXAMINER

LANKFORD JR, LEON B

ART UNIT PAPER NUMBER

1651

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,797

Applicant(s)

ERBE ET AL.

Examiner

L Blaine Lankford

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 and 56-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of group II is acknowledged. The traversal is on the ground(s) that there is no serious burden on the examiner. This is not found persuasive because the searches would indeed be burdensome.

The requirement is still deemed proper and is therefore made FINAL.

Claims 24-55 are considered on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "infiltrant" renders the claims indefinite because it is unclear what can be encompassed by this term. The scope is unclear and thus the claims fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "BMA" has no antecedent basis in claim 48.

Please note that the language of a claim must make it clear what subject matter the claim encompasses to adequately delineate its "metes and bounds". See, e.g., the

following decisions: In re Hammack, 427 F 2d. 1378, 1382, 166 USPQ 204, 208 (CCPA 1970); In re Venezia 530 F 2d. 956, 958, 189 USPQ 149, 151 (CCPA 1976); In re Goffe, 526 F 2d. 1393, 1397, 188 USPQ 131, 135 (CCPA 1975); In re Watson, 517 F 2d. 465, 477, 186 USPQ 11, 20 (CCPA 1975); In re Knowlton 481 F 2d. 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). The courts have also indicated that before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover. See, e.g., the following decisions: In re Steele, 305 F 2d. 859, 134 USPQ 292 (CCPA 1962); In re Moore 439 F 2d. 1232, 169 USPQ 236 (CCPA 1969); In re Merat, 519 F 2d. 1390, 186 USPQ 471 (CCPA 1975).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 24-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muschler (5824084).

Muschler teaches a composite bone graft which is made using a porous material and a BMA.

The reference does not teach that the BMA is partially coagulated however the reference does disclose that an anti-coagulant is preferred but does not require it. Embodiments wherein the anti-coagulant is not used would inherently contain some coagulation and thus read on what is instantly claimed.

While Muschler teaches that the use of an anti-coagulant is preferred, Muschler does not teach that it is required and as such teaches that the invention can be performed with a coagulated sample and provide the motivation to do so.

Therefore it would have been obvious at the time the invention was made to fill an osseous void using the method of Muschler wherein the BMA is at least partially coagulated.

As the references clearly indicate that the various proportions and amounts of the ingredients used in the claimed composition are result effective variables, they would be routinely optimized by one of ordinary skill in the art in practicing the invention disclosed by those references.

Accordingly, the claimed invention was prima facie obvious to one of ordinary skill in the art at the time the invention was made especially in the absence of evidence to the contrary.

Accordingly, the claimed invention was prima facie obvious to one of ordinary skill in the art at the time the invention was made especially in the absence of evidence to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to L Blaine Lankford whose telephone number is 571-272-0917. The examiner can normally be reached on Mon-Thu 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



L Blaine Lankford
Primary Examiner
Art Unit 1651